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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/880,769	06/15/2001	Georg Egloff	T2861-907262	5919

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EXAMINER

PICKARD, ALISON K

ART UNIT	PAPER NUMBER
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3676

DATE MAILED: 05/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 09/880,769	Applicant(s) EGLOFF, GEORG	
	Examiner Alison K. Pickard	Art Unit 3676	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-6 and 8-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 8-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |  |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-6, 8, 13, and 16-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Udagawa in view of Peterson (5,473,133).

Udagawa discloses a gasket (and method of making) comprising at least one metal layer 25 having a metal ring 23 welded thereto over a welding bead 26. The bead maintains the layer and ring in a spaced-apart relationship (e.g. see Fig. 2). The layer and ring are spaced from each other a distance that is constant around a through-hole, or the distance varies closer to and due to the projection of the weld bead or bead 25a. The gasket comprises two metal layers (Fig. 3). The metal layers have sealing beads. The layer and ring comprise steel. While Udagawa discloses that the gasket can comprise more than one bead, Udagawa does not disclose that the welding bead extends continuously around the through-hole. Peterson teaches projection welding. Peterson teaches that a projection weld can be made by plural beads 24 or a continuous bead 26. Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to form the welding bead as a continuous welding bead around the hole as such is an art equivalent taught by Peterson.

3. Claims 1-6, 8-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tanaka (5,690,342) in view of Opprecht (4,850,214).

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Tanaka discloses a gasket and method of manufacturing a gasket comprising at least one metal layer 1 (or 3) having at least one through-hole and at least one metal ring 2 welded thereto (col. 3, lines 65-67). Tanaka discloses the ring and layer can both be stainless steel. Tanaka discloses sealing beads 13 arranged opposite each other and beads 10 and 13 offset from each other. A further metal ring is arranged around the bead (see Figs. 5A and 5B). At least one of the metal layers 1 and 3 has a cranking 10 to align the metal ring 2. Tanaka discloses that the layer and ring are welded together. However, Tanaka does not disclose that layer and ring are welded together over a welding bead (i.e. via projection welding). Opprecht teaches that projection welds are used to obtain a high quality connection between metal components. Opprecht teaches that projection welding creates a better weld that is easier and more efficient to manufacture. Opprecht teaches that projection welding includes a projection (u-shaped) along which the items are welded together. Opprecht teaches using deformation limiters/abutments (see Fig. 8) during the welding to maintain the strength of the projection. As seen in Figures 3 or 4, the two substrates would be maintained in a spaced-apart relationship. The bead would be continuous around the hole. And, the layer and ring are spaced from each other a distance that is constant around a through-hole, or the distance varies closer to and due to the projection of the weld bead. Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify the weld used in Tanaka with the projection weld taught by Opprecht to create a higher quality connection that is easier and more efficient to manufacture.

#### ***Response to Arguments***

4. Applicant's arguments filed 2-9-04 have been fully considered but they are not persuasive, and some are moot in view of the new grounds for rejection.

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Udagawa discloses that plural beads can be formed symmetrically around the hole.

Peterson teaches that a continuous bead or plural beads can be used in forming a projection weld.

Regarding Applicant's argument that the combination of Tanaka in view of Opprecht renders Tanaka non-functional, the examiner disagrees. The lines (col. 3, lines 17-3) of Tanaka cited by Applicant state that the shim contacts the half-bead on a surface "where the bulges of the full-beads are not situated." In other words, Tanaka is stating that the shim is on concave surface side of the full-bead. Considering Tanaka's full disclosure, the function of the shim is not to merely be in contact with a surface of a half bead. Rather, Tanaka discloses the shim is desirably located at the half bead in order to increase the thickness at this region (see col. 4, lines 30-34). Modifying Tanaka by projection welding the shim (as taught by Opprecht) would not change the function of the shim in the gasket. The shim would still be in its required location. Further, the shim would be in contact with that surface of the half-bead via the projection weld.

Regarding claim 3, the spaced distance between the ring and layer would vary around the through hole as it approaches the weld bead because of the shape of the bead.

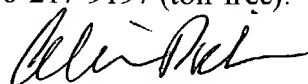
### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alison K. Pickard whose telephone number is 703-305-0882. The examiner can normally be reached on M-F (10-7:30), with alternate Friday's off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Judy Swann can be reached on 703-306-4115. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Alison K. Pickard  
Primary Examiner  
Art Unit 3676

AP